

REMARKS

Applicants believe that the following comments will convince the Examiner that the rejections set forth in the August 18, 2003 Office Action have been overcome and should
5 be withdrawn.

Furthermore, Applicants are submitting herewith a terminal disclaimer to limit the term of the patent resulting from this application to that of Applicants' U.S. Pat. No. 6,164,534 (the "'534 patent"). Applicants want to
10 bring the '534 patent to the Examiner's attention since the Examiner may believe its claims are not patentably distinct from (or in fact encompass) the present invention. Claim 1 from the '534 patent is illustrative:

1. A system for displaying programming to a user, the
15 system comprising:

a printed matter having at least one machine recognizable feature;

20 a feature recognition unit having associated therewith a means for recognizing said feature and a transmitter for transmitting a coded signal in response to the recognition of said feature;

25 an intelligent controller having associated therewith a receiver for receiving said coded signal and means for accessing programming material; and

30 a display unit for presenting said programming material;

wherein said recognition unit, in response to the recognition of said feature, causes said

intelligent controller to access said programming material and said display unit to execute or display said programming material.

I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a textbook
5 comprising at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. In the present invention, a machine recognizable feature is
10 scanned or sensed, and converted into an electronic signal, which is transmitted for processing. In response to the electronic signal, programming material related to the information contained in the textbook is displayed. Importantly, the present invention is designed to allow a
15 user to access programming material related to the textbook.

II. THE EXAMINER'S REJECTIONS

The Examiner rejected claims 168-180, 183-185, 202, 203, 228-251, 256, 259-262, 267-269, 272, 283, 288, and 290-293 under 35 U.S.C. § 103(a) as being unpatentable over Withnall et al. U.S. Patent No. 4,488,035 (hereinafter referred to as "Withnall") in view of Fields U.S. Patent No. 4,481,412 (hereinafter referred to as "Fields") and Nobles et al. U.S. Patent No. 4,820,167 (hereinafter referred to as "Nobles"). The Examiner opined that Withnall discloses a system that includes a feature recognition device that reads at least one machine recognizable feature printed on a travel ticket to display travel information on the display of a portable handset. However, the Examiner admitted that:

"Withnall et al fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal." (August 18, 2003 Office Action, p. 2).

The Examiner contended that Fields teaches these features by disclosing a microcontroller accessing means that includes a "barcode electronic circuit" coupled to a barcode reader, wherein the microcontroller accesses and

transmits programming material in response to receiving a coded signal. The Examiner argued that the system disclosed in Fields displays "video/image/programming/sound/pictorial/electronic/media data" on a "television
5 /workbook."

The Examiner stated that combining the systems disclosed in Withnall and Fields would have been obvious at the time of Applicants' invention:

10 "in order to provide Withnall et al with a higher technology system wherein the user being provided with a full complete information [sic] in a flexible ways [sic] ... Furthermore, such modification would have been an obvious extension as taught by Withnall et al." (August 18, 2003
15 Office Action, p. 3).

The Examiner then admitted that Withnall and Fields fail to teach a system comprising information related to a textbook, which is claimed to be disclosed in Nobles. The
20 Examiner argued that the combination of Nobles with Withnall and Fields would have been obvious to provide:

25 "a more user-friendly system wherein the students do not have to [be] concern[ed] about carrying [a] heavy bag of hardcopy textbooks, and they can retrieve their desired information that [is] related to their study readily through the electronic textbook/device. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields." (August 18,
30 2003 Office Action, p. 3).

Also, the Examiner rejected claims 181, 182, 187, 188, 190, 196, 197, 199, 200, and 221-227 under 35 U.S.C. §

103(a) as being unpatentable over Withnall as modified by
Fields and Nobles "as applied to claim 168" in view of
Roberts U.S. Patent No. 5,324,922 (hereinafter referred to
as "Roberts") and Malec *et al.* U.S. Patent No. 5,287,266
5 (hereinafter referred to as "Malec"). The Examiner
admitted that Withnall, Fields, and Nobles fail to teach
online or home shopping and a cable television data link,
and argued that these features are disclosed by Roberts.
According to the Examiner, the combination of Roberts with
10 Withnall, Fields, and Nobles would have been obvious and
would provide:

15 "a faster system due to the benefit of cable
television transmitting capability. Furthermore,
such modification would have been an obvious
extension as taught by Withnall *et al.*/
Fields/Nobles *et al.* to provide the user an
alternative way of doing shopping." (August 18,
2003 Office Action, p. 4).

20 Moreover, the Examiner admitted that Withnall, Fields,
Nobles, and Roberts all fail to disclose an Integrated
Service Digital Network ("ISDN") data link which, according
to the Examiner, is disclosed by Malec. In the opinion of
the Examiner, the combination of Malec with Withnall,
25 Fields, Nobles, and Roberts would have been obvious for
providing:

"a more accurate and faster system due to the
benefit of ISDN networking line[s]. Furthermore,
such modification would have been an obvious

extension as taught by Withnall et al./Fields/Nobles et al./Roberts and would have been merely a substitution of equivalents." (August 18, 2003 Office Action, pp. 4-5).

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Next, the Examiner rejected claims 186, 189, 191, 193-195, 198, 201, 206-208, 210, 211, 216, 217, 220, 252-255, 257, 258, 266, 271, 273-275, 286, and 289 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Nobles "as applied to claim 168" in view of Bravman et al. U.S. Patent No. 5,401,944 (hereinafter referred to as "Bravman"). The Examiner admitted that Withnall, Fields, and Nobles fail to teach displaying information on a wireless communication device. According to the Examiner, Bravman teaches a remote unit providing travel-related information, and the combination of Withnall, Fields, Nobles, and Bravman would have been obvious for providing:

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"a more flexibility [sic] system wherein the system is capable of providing the user all of his/her desired information about the trip/vacation that he/she is about to take, and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al./Fields/Nobles et al." (August 18, 2003 Office Action, pp. 5-6).

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Also, the Examiner rejected claims 204, 209, and 212 under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Nobles "as applied to claim 168"

in view of Waterbury German Patent No. DE 24 52 202 A1 (hereinafter referred to as "Waterbury"). The Examiner admitted that Withnall, Fields, and Nobles fail to teach an invisible machine recognizable feature, which is argued to be taught by Waterbury. The Examiner asserted that the combination of Waterbury with Withnall, Fields, and Nobles would have been obvious for providing:

"a more secure system wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, thus preventing manipulating [sic] by [a] fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall et al./Fields/Nobles et al." (August 18, 2003 Office Action, p. 6).

Next, the Examiner rejected claims 205 and 219 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Nobles "as applied to claim 168" in view of Tannehill et al. U.S. Patent No. 5,158,310 (hereinafter referred to as "Tannehill"). The Examiner admitted that Withnall, Fields, and Nobles all fail to disclose a "magnetic code/strip," which is argued to be disclosed by Tannehill. The Examiner contended that the addition of Tannehill to Withnall, Fields, and Nobles provides "an alternative feature for encoding data. Furthermore, such modification would have mere[ly] been a substitution of equivalents." (August 18, 2003 Office Action, p. 7).

Additionally, the Examiner rejected claims 213-215 and 218 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Nobles "as applied to claim 168" in view of Schach *et al.* U.S. Patent No. 5,397,156 (hereinafter referred to as "Schach") and Waterbury. The Examiner admitted that Withnall, Fields, and Nobles fail to teach a watermark, which is argued to be taught by Schach. In the Examiner's opinion, the combination of Schach with Withnall, Fields, and Nobles would have been obvious for aesthetic purposes. "[S]uch modification would have been an obvious extension as taught by Withnall/Fields/Nobles." (August 18, 2003 Office Action, p. 8).

The Examiner then admitted that Withnall, Fields, Nobles, and Schach fail to teach an invisible watermark, which the Examiner argued is taught by Waterbury. The Examiner asserted that the combination of Withnall, Fields, Nobles, Schach, and Waterbury would have been obvious for providing:

"a more secure system wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, thus preventing manipulating [sic] by [a] fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall *et al.*/Fields/Nobles *et al.*/Schach *et al.*" (August 18, 2003 Office Action, p. 8).

Also, the Examiner rejected claims 192, 263-265, 270, 271, 276-282, 284, 285, and 287 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Nobles "as applied to claim 168" in view of Morales U.S. Patent No. 5,872,589 (hereinafter referred to as "Morales"). The Examiner admitted that Withnall, Fields, and Nobles fail to teach a display unit comprising a "personal planner/phone/pager," which is argued to be taught by Morales. In the Examiner's opinion, combining Withnall, Fields, Nobles, and Morales would have been obvious to provide:

"the user with the flexibility of selecting his/her desired display unit that is fitting [sic] his/her needs, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Nobles et al." (August 18, 2003 Office Action Summary, p. 11, paragraph 11).

III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

The Examiner rejected claims 168-180, 183-185, 202, 203, 228-251, 256, 259-262, 267-269, 272, 283, 283, 288, and 290-293 under 35 U.S.C. § 103(a) as being unpatentable over Withnall, Fields, and Nobles. Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of Withnall, Fields, and Nobles. In order for a claimed invention to be obvious in view of a

combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation to modify or combine Withnall, Fields, and Nobles exists.

"Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original).

The Examiner contended that it would have been obvious to combine the teachings of Withnall, Fields, and Nobles to arrive at the various embodiments of Applicants' invention. Yet, the Examiner has cited only purported benefits of this combination without pointing to what motivation is provided by the references themselves. Applicants submit that no

combination of these references would have been obvious to one of skill in the art at the time of Applicants' invention. Specifically, Withnall discloses a system for utilizing barcodes on commuter tickets to test for validity. The Examiner suggests that "travel information which can be retrieved once barcode [sic] on the ticket has been read can be considered programming material...associated with the barcode." (August 18, 2003 Office Action, p. 10) Applicants respectfully submit however, that this does not constitute programming material. The "travel information" referred to by the Examiner is encoded within the barcode on the ticket. The system of Withnall reads this information from the barcode, it does not retrieve it from a separate database. The barcode or the data encoded therein do not themselves constitute programming material. Indeed, the only interaction the barcode has with a database is a mere validity check, i.e., the comparison of data on the ticket to stored reference data.

This purpose is far removed from the intent of the training system disclosed by Fields. The training system of Fields is used to provide a user with audio/visual output from a videodisc player coinciding with material presented in a training manual. Fields relies on a read-

only videodisc thereby sacrificing updatability and flexibility. In fact, Fields does not even contemplate the ability to interface with a remote server or an updatable video source. Thus, there is no suggestion to combine a travel ticket verification system that does not provide programming material with a training system that automatically cues to a certain frame on a videodisc. The mere fact that both can use a barcode is an insufficient basis to suggest their combination.

Moreover, the ticket validation system of Withnall has no apparent relation to Nobles' school teaching system. Specifically, Nobles discloses a personal computer system designed to link to a master computer to download educational material and also to facilitate in test or quiz administration. The Examiner relies on Nobles for teaching that the programming material received by scanning a barcode within a textbook "comprises information related to a textbook." Nobles, instead, teaches against the combination asserted by the Examiner:

"The overall system is made possible by a small, fully portable unit which is assigned to each student and which replaces all text-books."
(Nobles, col. 1, line 67 through col. 2, line 2)
(emphasis added)

Clearly, Nobles suggests that textbooks themselves should be eliminated and replaced with electronic versions.

That is not the present invention. The present invention is an improvement upon textbooks—it does not seek to eliminate them. In fact, one object of the present invention is to make programming material (e.g., a web
5 page) accessible to a user via a familiar printed medium. The present invention recognizes that many people are unfamiliar and uncomfortable with high-technology devices (e.g., electronic textbooks), and thus, provides simple access to programming material via a familiar medium (e.g.,
10 a standard textbook). By eliminating the familiar medium, Nobles entirely misses the point of the present invention. Indeed, a person skilled in the art would be discouraged from incorporating any of Nobles' teachings into a conventional textbook.

15 The differing purposes of these three references have no overlap in use, and therefore, would not provide one skilled in the art with a motivation or suggestion to combine these references. Thus, an inventive step must be performed for one skilled in the art to arrive at the idea
20 of combining any features of Withnall, Fields, or Nobles in any combination. Furthermore, by eliminating textbooks entirely, Nobles teaches against the combination suggest by the Examiner and negates an important feature of the present invention.

Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

"It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law."

Applicants submit that the only suggestion or motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

In addition to the lack of suggestion or motivation to combine Withnall, Fields, and Nobles, there is no expectation of success for the combination of these references, and any possible resulting device would not
5 teach or suggest all of the limitations of the rejected claims. Withnall discloses a machine capable of scanning a bar code on a commuter ticket and subsequently displaying the validity of the ticket based on information stored in a memory means. Fields discloses a system for reading a bar
10 code on a training manual for playing corresponding material from a videodisc. Nobles discloses a replacement for textbooks that administers tests and educational material. Applicants respectfully submit that the combination of Withnall, Fields, and Nobles cannot be
15 successfully combined to disclose the means for accessing programming material associated with a database or the textbook having a machine recognizable feature of the claimed invention. Importantly, claims 168, 288, and 291 all disclose the accessing of programming material
20 resulting from recognition of a machine recognizable feature. The programming material of the present invention is designed such that it can be easily altered or updated at any time. As a result, a user will be provided with the most recently updated version of the associated information

(or programming material) upon scanning a textbook. This is not possible with the combination of Withnall, Fields, and Nobles. Specifically, audio/visual material from the videodisc player of Fields requires that a videodisc player
5 would be located on, for example, a bus. Because videodiscs are read-only, each time information must be updated, a new videodisc must be inserted into the videodisc player. This is not feasible, especially because the validity of a ticket can change each time a ticket is
10 used and could require a new videodisc to be employed every time a ticket is used. Furthermore, implementing the personal computer of Nobles would eliminate the textbook entirely. Moreover, the radio data link of Withnall cannot be utilized to access a remote videodisc player or other
15 such audio/visual material because the radio data link is designed only for transmitting a validity state and not substantially different audio/visual material. In particular, audio/visual material requires substantially more data to be transmitted in a specialized format. Thus,
20 a system for achieving such transmission would need to be invented and implemented for remotely accessing such material.

Additionally, the textbook having a machine recognizable feature as claimed is not disclosed within the

combination. The Examiner relies on Nobles to provide "information related to a textbook." However, Nobles does not disclose a textbook of any sort. Instead, Nobles seeks to "replace[] all textbooks." (col. 2, lines 1-2). "The
5 unit includes a display screen, typically a liquid crystal screen, approximating the size of an open book." (col. 2, lines 13-15). Thus, Nobles intends to replace textbooks and does not provide or even contemplate any textbooks providing machine recognizable features. Moreover, Nobles
10 never mentions machine recognizable features. Nobles, therefore, cannot be relied upon for disclosing a textbook having a machine recognizable feature. Therefore, any attempt to combine Withnall, Fields, and Nobles to create the claimed invention would be unsuccessful and fails to
15 provide the flexible, updateable system including a system for obtaining and surveying correlated programming material of the claimed invention as opposed to a comparison of the identity of a printed code with a code stored in a database. Moreover, the advanced system for providing
20 programming material and a textbook comprising a machine recognizable feature of the claimed invention are not disclosed by the combination of these references.

In view of the foregoing, base claims 168, 288, and 291 cannot be unpatentable over Withnall, Fields, and

Nobles. The remaining rejected claims are dependent on these claims and contain all of the limitations of their respective base claims. Therefore, these claims are also not unpatentable over these references.

5 In all subsequent rejections, the Examiner noted the deficiencies of the Withnall, Fields, and Nobles combination regarding matter disclosed in dependent claims and appended various other references including Roberts, Malec, Bravman, Waterbury, Tannehill, Schach, and Morales
10 to the combination in order to provide the additional features of the dependent claims. However, the combination of Withnall, Fields, and Nobles has been shown to be not only improper, but also to lack the disclosure of each and every element of the base claims. Because this combination
15 is improper and incomplete, any further combination of references with Withnall, Fields, and Nobles would also be improper. Thus, Applicants respectfully submit that all remaining rejections have also been overcome and should be withdrawn.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

Date: _____

2/10/04



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